



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Andreas Bernkop-Schnurch

Application No.: 09/830,986

Filing Date: May 3, 2001

Group Art Unit: 1617

Examiner: Shahnam Sharareh

Confirmation No.: 7285

Title: MUCO-ADHESIVE POLYMERS, USE THEREOF AND METHOD FOR PRODUCING THE SAME

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

A Petition for Extension of Time is also enclosed.

Terminal Disclaimer(s) and the \$65.00 (2814) \$130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

Also enclosed is/are _____

Small entity status is hereby claimed.

Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the \$395.00 (2801) \$790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.

Applicant(s) previously submitted _____

on _____, for which continued examination is requested.

Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

No additional claim fee is required.

An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	82	MINUS 82 =	0	x \$50.00 (1202) =	\$ 0.00
Independent Claims	16	MINUS 16 =	0	x \$200.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$360.00 (1203)					
Total Claim Amendment Fee					
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					

A check in the amount of _____ is enclosed for the fee due.

Charge _____ to Deposit Account No. 02-4800.

Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

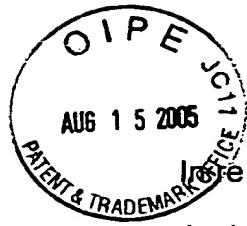
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: August 15, 2005

By 
Susan M. Dadio
Registration No. 40,373



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of)
Andreas BERNKOP-SCHNÜRCH) Group Art Unit: 1617
Application No.: 09/830,986) Examiner: Shahnam J. Sharareh
Filed: May 3, 2001) Confirmation No.: 7285
For: MUCO-ADHESIVE POLYMERS,)
USE THEREOF AND METHOD FOR)
PRODUCING THE SAME)

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Communication mailed on July 13, 2005 whereby the Examiner has required restriction amongst the currently pending, applicant hereby elects, with traverse, Group I – claims 1, 28-33 and 35-38 – which as stated in the Office Communication is “drawn to a [mucoadhesive] polymer exhibiting a total work adhesion of more than 120 micro jules to intestinal mucosa at a pH of 7.” OFFICE COMMUNICATION at 2.

This application was filed on May 3, 2001 as a national stage application under 35 U.S.C. § 371 of International Application No. PCT/AT99/00265. The first Office Action on the merits, which was mailed on March 27, 2002, included a complete examination of then pending claims 1 and 28-99. No lack of unity requirement was made by the Examiner, rather all of the pending claims were fully examined. On August 27, 2002, applicants added new claims 100-108. The final Office Action, which was mailed on April 9, 2003, examined then pending claims 1

and 28-108. Again, no lack of unity of invention was ever made. In response to the final Office Action, applicant submitted an Amendment which included the addition of new independent claim 109. After receipt of an Advisory Action, applicants filed a Request for Examination.

Now, after years of prosecuting practically every claim currently pending in a single application, the Examiner has decided to impose a lack of unity of invention requirement. However, the history in this case establishes that there is not a serious burden on the Examiner to examine all the claims in a single application. This is because (with the exception of new claim 109) all of the claims were previously examined by the Examiner in the same application. Incidentally, claim 109 has been grouped with other claims (Group VII – claims 74-81 and 100-109) that were previously examined on the merits in the same single application. Since there is no serious burden on the Examiner to examine all the presently pending claims in a single application, the lack of unity requirement is not proper and should be withdrawn.

The Examiner has also required applicant to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. Initially, similar to the lack of unity requirement, an election of species requirement (which is supposed to be made before a search on the merits) is improper at this stage since the alleged "generic" claims have already been fully examined on the merits. Second, in making an election of species requirement, the Examiner is required to "clearly identify each . . . of the disclosed species, to which the claims are restricted." M.P.E.P. § 809.02(a) (emphasis omitted). Here, the Examiner has not clearly identified the species to which the claims are to be restricted and thus

applicant is unable, without further clarification by the Examiner, to make an election of species.

The Examiner has stated that the species are "[v]arious polymeric moieties encompassing numerous monomeric units." However, the Examiner has failed to clearly identify what the various polymeric moieties are for which applicant is supposed to elect one such species for examination purposes. Without this further clarification, applicant is unable to make any type of election.

Thus, while applicant believes that the election of species requirement is improper after such claims have already been fully examiner on the merits and no election should therefore be required, applicant is unable to elect a single disclosed species in the absence of the Examiner's clear indication as to the species from applicants are supposed to elect.

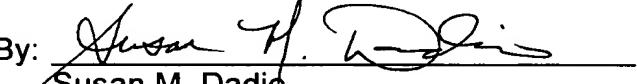
Applicant reserves the right to file one or more divisional applications directed to any of the non-elected subject matter

In the event that there are any questions relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would contact the undersigned attorney at concerning such questions so that prosecute of this application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL PC
(Including attorneys from Burns, Doane,
Swecker & Mathis)

Date: August 15, 2005

By: 
Susan M. Dadio
Registration No. 40,373

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